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6/16/04
CUSTOMER NUMBER 27792

1 IN THE UNITED STATES PATENT AND TRADEMARK OFFICE
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3 Appellant: Craig Ranta Attorney Docket No: MICR0230
4 Serial No: 09/476,291 Group Art Unit: 2611
5 Filed: December 30, 1999 Examiner: Chung, Jason J.
6 Title: METHOD AND SYSTEM FOR DOWNLOADING, STORING AND
7 DISPLAYING COUPON DATA USING THE HORIZONTAL OVERSCAN
8 PORTION OF A VIDEO SIGNAL

APPEAL BRIEF

9 Bellevue, Washington 98004

10 June 3, 2004

11 TO THE DIRECTOR OF THE PATENT AND TRADEMARK OFFICE:

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26 This is an appeal from a final rejection by Examiner Jason Chung of Group Art Unit 2611. A
27 Final Rejection was mailed on January 26, 2004. Appellant filed a Notice of Appeal on
28 April 28, 2004 and paid for a one month extension of time to reply to the Office Action at that time.

29 The jurisdiction of this board is invoked under the provisions of 35 U.S.C. § 134 and 37
30 C.F.R. §§ 1.191-192.

06/08/2004 AF1 00000089 09476291

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REAL PARTY OF INTEREST

The real party of interest in this appeal is hereby identified as Microsoft Corporation, since all right and title in the invention and in the patent application on appeal has been assigned to Microsoft Corporation, as evidenced by a chain of title from the inventors of the patent application identified above to the current assignee, as shown below:

From inventor **Craig Ranta** (assignment executed March 20, 2000) to **Microsoft Corporation**. The assignment was recorded in the Patent and Trademark Office on April 10, 2000 at Reel 010679, Frame(s) 0654.

RELATED APPEALS AND INTERFERENCES

No other appeals or interferences are known to appellants, appellant's undersigned legal representative, or by the assignee of this application that will directly affect or be directly affected by or have a bearing on the Board's decision in this pending appeal.

STATUS OF THE CLAIMS

Claims 1-29 and 31 remain pending in the application on appeal. Claim 30 was cancelled previously. Appellants hereby appeal the final rejection of Claims 1-29 and 31.

STATUS OF THE AMENDMENTS

An Amendment and Request for Reconsideration in response to the Final Office Action in this application was mailed on March 4, 2004. An Advisory Action dated March 24, 2004 indicated that for purposes of appeal, the amendment would be entered. No further amendment has been filed.

A copy of the claims on appeal, including all amendments actually entered, is appended hereto.

SUMMARY OF THE INVENTION

The present invention is directed to an electronic coupon created using a portable computing device configured to receive electronic coupon data that have been extracted from the horizontal overscan portion of a video signal. Advertisers can encode electronic coupon data for transmission with a video signal. For example, an advertiser for tires might encode coupon data in the video signal of a commercial for tires, so that the coupon data are employed to produce an electronic coupon that can be redeemed for a discount when purchasing tires in a retail establishment.

The electronic coupon includes a display (preferably an LCD screen) so that coupon data can be viewed. In one embodiment, the electronic coupon is configured to display a bar code that can be scanned at a retail establishment to redeem the coupon. The electronic coupon further includes a

1 processor and a memory. Machine instructions are stored in the memory and are executed by the
2 processor. The machine instructions control the operational characteristics of the electronic coupon.
3 The electronic coupon also includes a receiver that receives the coupon data. In one embodiment, an
4 external decoder receives an encoded video signal (i.e., a video signal into which coupon data have
5 been encoded in the horizontal overscan portion thereof), and extracts the coupon data from the
6 encoded video signal. The decoder then transmits the extracted coupon data to the electronic
7 coupon. In another embodiment, the decoder is integrated into the electronic coupon, such that the
8 receiver in the electronic coupon is configured to receive the encoded video signal, and the
9 electronic coupon itself extracts the encoded coupon data from the horizontal overscan portion of the
10 video signal. In an exemplary embodiment, the receiver comprises electrical contacts configured to
11 engage electrical contacts on an external device (the decoder providing the extracted coupon data or
12 the source of the encoded video signal).

13 To achieve a simple device, the electronic coupon preferably includes only a limited number
14 of controls. In one preferred embodiment, the electronic coupon includes a mode key, a select key,
15 an up key, and a down key. The mode key enables the user to toggle between a set up mode, a
16 storage mode, and a redeem mode (specification, page 8, lines 2-11). The set up mode enables a
17 user to define the types of coupons to receive (i.e., to store), the storage mode enables the electronic
18 coupon to process incoming data (extracted coupon data or an encoded video signal, where the
19 decoder is part of the electronic coupon), and the redeem mode enables a specific electronic coupon
20 to be redeemed (by displaying the coupon data, such as a bar code) or deleted. The mode key
21 enables the user to toggle through the modes as they are sequentially displayed on the LCD screen.
22 The up and down keys are used to navigate through lists. Two types of lists are displayed to the user
23 of the electronic coupon, including a list in the set up mode and a list in the redeem mode.

24 In the set up mode, the list is a menu of coupon categories. The user can use the up and
25 down keys to scroll through the categories, and manipulate the select key to select a specific coupon
26 category. When the electronic coupon is placed in the receive mode, only coupon data
27 corresponding to a coupon category affirmatively selected by the user in the set up mode will be
28 stored in the electronic coupon (i.e., in the memory of the electronic coupon). All other coupon data
29 are discarded (page 9, lines 3-5). This approach overcomes a problem in many small portable
30 computing devices -- a small amount of memory resources. When the memory is full, such that no
additional coupons can be stored, a warning message is displayed to the user.

In the redeem mode, the list displayed is a list of all those coupons that have been received and stored (i.e., all those coupons not discarded). The user can scroll through the list and select a specific coupon. When the electronic coupon is placed in the redeem mode, the selected coupon will be displayed for redemption. Saved coupons can also be selected from the list for deletion from the memory (page 10, lines 5-12).

ISSUES PRESENTED FOR REVIEW

1. A determination as to whether the invention defined by Claims 1-27, 29, and 31 is patentable under 35 U.S.C. § 103(a) over Williams et al. (U.S. Patent No. 6,075,971) in view of Mankovitz et al. (U.S. Patent No. 5,523,794), and further in view of Small (U.S. Patent No. 5,808,689) and Terrill et al. (U.S. Patent No. 6,052,755).

2. A determination as to whether the invention defined by Claim 28 is patentable under 35 U.S.C. § 103(a) over Mankovitz (U.S. Patent No. 5,523,794) in view of Small (U.S. Patent No. 5,808,689).

GROUPING OF CLAIMS

In regard to the rejection of the claims as unpatentable under 35 U.S.C. § 103(a) over Williams et al. (U.S. Patent No. 6,075,971) in view of Mankovitz et al. (U.S. Patent No. 5,523,794), and further in view of Small (U.S. Patent No. 5,808,689) and Terrill et al. (U.S. Patent No. 6,052,755), Claims 1, 3-8, 11, 12, 13-23, and 27 stand or fall together. Claims 2, 24, and 25 stand or fall together. Claims 9, 10, 26, 29, and 31 also stand or fall together. Thus, the rejection based on Williams in view of Mankovitz, Small, and Terrill will require a three-part analysis.

In regard to the rejection of the claims as unpatentable under 35 U.S.C. § 103(a) over Mankovitz (U.S. Patent No. 5,523,794) in view of Small (U.S. Patent No. 5,808,689), Claim 28 stands or falls alone.

ARGUMENT

Rejection of Claims 1, 3-8, 11, 12, 13-23, and 27 under 35 U.S.C. § 103

The Examiner has rejected Claims 1, 3-8, 11, 12, 13-23, and 27 under 35 U.S.C. § 103(a) as being unpatentable over Williams et al. (U.S. Patent No. 6,075,971) in view of Mankovitz et al. (U.S. Patent No. 5,523,794), and further in view of Small (U.S. Patent No. 5,808,689) and Terrill et al. (U.S. Patent No. 6,052,755). The Examiner indicates that Williams discloses a set up mode, which enables users to complete preference profiles that can be used to filter coupons; that

1 Mankovitz discloses a portable coupon including keys, memory, a controller and a display; that
2 Small discloses encoding and decoding data using the horizontal overscan portion of a video signal;
3 and that Terrill discloses that RAM and ROM can be used interchangeably. The Examiner appears
4 to conclude that an artisan of ordinary skill would have been led to combine and modify these
5 references to achieve an invention equivalent to appellant's claimed invention in order to provide a
6 more versatile system and method for distributing electronic coupons.

7 Appellant's independent Claims 1, 13, and 31 each share the common element (recited either
8 as a step or as a function implemented by a processor) of displaying a menu of coupon categories to
9 a user, and enabling a user to select one or more of those coupon categories, and filter the coupons to
10 be stored by the electronic coupon. Appellant disagrees that the set up mode and preference profiles
11 disclosed by Williams are equivalent to appellant's set up mode and menu of coupon categories.
12 Specifically, Williams does not teach or suggest displaying a menu of coupon categories to a user,
13 and Williams does not teach or suggest controlling coupon delivery by manipulating preference
14 profiles, particularly where a user might manipulate the preference profile to include a category that
15 the user dislikes, in order to be able to receive coupons for that category (for example, to use in
16 purchasing a gift for another person who likes goods falling under that category). The cited art does
17 not provide any suggestion or motivation to modify the teaching of Williams to enable the cited art
18 to be combined and modified to achieve an equivalent to appellant's claimed invention.

19 The Examiner correctly indicates that Williams discloses preference profiles, and that
20 preference profiles can be used to filter coupons. However, the further conclusion of the Examiner
21 that a preference profile is therefore equivalent to a menu of coupon categories, is NOT correct.
22 Williams specifically states that preference profile can be generated based on: (1) observing a user's
23 entertainment selections; (2) enabling a user to specifically indicate various preferences when
24 registering with the entertainment network; and (3) enabling a user to specifically indicate various
25 preferences as part of some promotion associated with the entertainment network. It is significant
26 that Williams never specifically teaches *how* a user affirmatively completes a preference profile
27 during registration or during a promotion. Based on the disclosure provided by Williams, there is no
28 reason to conclude that a preference profile is generated by displaying a menu of different coupon
29 categories to a user, such that the user is able to select specific coupon categories from that menu.

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1 Furthermore, there is no evidence that a user of the entertainment network disclosed by
2 Williams *is informed that a decision to include a specific preference in a preference profile will result*
3 *in the delivery of coupons related to that preference.* It is important to recognize that Williams
4 discloses an entertainment network. When registering for an entertainment network, many users
5 would logically assume that by indicating they are interested in specific categories (such as sports and
6 science fiction), they would receive information about sports programming and science fiction
7 programming offered by the entertainment network. Williams provides no details about promotions on
8 an entertainment network, and no details as to how a user would create or indicate a preference during
9 such a promotion. There simply is no evidence provided in the cited art that would lead one of
10 ordinary skill to understand that when a user indicates a preference for sports and science fiction, the
11 user has actually affirmatively elected to receive advertising information (coupons) related to sports
12 and science fiction, since the choice to receive the delivery of advertising coupons related to a category
13 of entertainment selected is outside the scope of the indicated preference.

14 While an astute user might recognize a possible link between the user's preference profile
15 and the type of coupons delivered to the user, there simply is no disclosure or suggestion by
16 Williams that a user of the entertainment system is ever taught to change their preference profile in
17 order to control the types of coupons delivered or that would indicate a user would be expected to
18 know that the preference profile is used to control the types of coupons delivered. The Examiner
19 relies upon a statement by Williams that preference profiles may be affirmatively indicated by a user
20 "...as part of some other promotion (column 6, line 7)." Based on that statement, the Examiner
21 concludes that Williams teaches a user can access a menu of coupon categories during a promotion
22 and control the type of coupons the user will receive, so that a user can change the preference
23 profiles specifically to receive coupons related to areas not corresponding to the user's actual
24 preferences (i.e., so that a user can receive coupons for a specific product or service, even when that
25 product or service does not correspond to any category of entertainment the user wishes to receive
26 programming for). That's reading an enormous amount into *as part of some other promotion.* Even
27 if *as part of some other promotion* is understood to mean that a user of Williams' system is taught to
28 manage the types of coupons delivered by changing their preference profiles (and such a conclusion
29 is unwarranted), Williams never teaches displaying a menu of coupon categories to a user to enable
30 the user to change his or her preference profile.

1 Filtering coupons based on preference profiles, as disclosed by Williams, is likely to achieve
2 a different result than filtering coupons in accord with appellant's menu of coupon categories. Note
3 that merely because a person has an interest in a certain activity or topic does not mean that the
4 person *wants* or needs to receive coupons related to that interest, and similarly, people often *need*
5 products or services unrelated to their interests. When told to create a preference profile based on
6 their likes or dislikes, a user is likely to make different choices than when presented with a menu of
7 coupon categories, and told to select only those categories for which they wish to receive related
8 coupons. For example, a user might like sports but not auto racing or automobiles, and complete a
9 preference profile in Williams' system indicating such. The same person may need tires, but not
10 sporting equipment. Based on Williams disclosure, such a user's interest in sports would be noted in
11 their preference profile, and the user would only receive coupons for sports equipment. The user's
12 lack of interest in automobiles might also be noted, and thus the user would not receive coupons
13 related to automobiles, such as coupons related to tires. The same user employing appellant's
14 electronic coupons could select tires from a menu of coupon categories, and not select sporting
15 equipment, and thus receive coupons targeted to their specific needs, as opposed to their interests.
16 Williams' disclosure related to promotions (*as part of some other promotion*) is simply too limited to
17 teach or suggest to one of ordinary skill in the art that a user might manipulate the preference profile
18 to control the delivery of coupons to reflect a transient interest or need, particularly when such a
19 transient interest would result in inaccurately completing a preference (e.g., inaccurately indicating
20 that a user likes automobiles to enable coupons to be received relating to tires or other automotive
accessories).

21 The Examiner has indicated in the Advisory Action of March 24, 2004 that because there is a
22 disagreement as to whether a menu of coupon categories is equivalent to preference profiles, the
23 Examiner has *read the claims in light of the specification*, to determine the meaning of a menu of
24 coupon categories. Based on such a reading, the Examiner asserts that appellant's menu of coupon
25 categories is identical to the preference profiles disclosed by Williams, because coupons are filtered
26 based on user selections. Such a conclusion ignores the fact the Williams simply does not teach or
27 suggest the step of displaying a menu of *coupon categories* to a user. Instead, Williams discloses
28 the following. "Gathering of preference data may be accomplished, for example, by observing or
29 otherwise determining the type of television programming or other entertainment a particular user
30 selects. Alternatively, users may disclose various preferences as part of registering with the

1 entertainment network or as part of some other promotion (Column 6, lines 2-7). With respect to
2 looking to the specification for the meaning of *a menu of coupon categories*, the meaning of the term
3 is self evident. Appellant's specification clearly describes the menu of coupon categories as a
4 plurality of entries that are displayed to the user, such that the user can scroll through the entries and
5 select specific coupon categories (products and services) from the list (see appellant's specification,
6 page 8, line 20 through page 9, line 5).

7 Even if the references are combined in the manner suggested by the Examiner, the result
8 achieved is not equivalent to the invention defined in independent Claims 1, 13, and 27, because
9 (1) the cited art does not teach or suggest displaying a menu of coupon categories to a user, and
10 (2) the coupon filtering as disclosed by Williams is based on determining a user's preferences profile
11 for use in an entertainment system, where both entertainment programming and related coupons are
12 provided to the user. In Williams' system, a user simply indicates what the user likes. In appellant's
13 invention, what a user *likes* is irrelevant, because the user specifically indicates those goods and
14 services *for which coupons are desired*. Clearly, these two techniques are not identical or
15 equivalent. Regardless of whether Williams discloses a method to achieve coupon filtering, the
16 specific steps (i.e., displaying a menu of coupon categories, and enabling a user to select specific
17 coupon categories from the menu) employed by appellant's claims are distinguishable over
18 Williams, and the cited art, alone or in combination, does not teach or suggest the modifications
required to achieve an equivalent invention.

19 Rejection of Claims 2, 24, and 25 under 35 U.S.C. § 103

20 The Examiner has rejected Claims 2, 24, and 25 under 35 U.S.C. § 103(a) as being
21 unpatentable over Williams et al. (U.S. Patent No. 6,075,971) in view of Mankovitz et al. (U.S.
22 Patent No. 5,523,794), and further in view of Small (U.S. Patent No. 5,808,689) and Terrill et al.
23 (U.S. Patent No. 6,052,755). The Examiner indicates that Williams discloses a set up mode, which
24 enables users to complete preference profiles that can be used to filter coupons, that Mankovitz
25 discloses a portable coupon including keys, memory, a controller and a display, *and an integrated*
26 *decoder*. The Examiner appears to conclude that an artisan of ordinary skill would have been led to
27 combine and modify these references to achieve an invention equivalent to appellant's claimed
28 invention in order to provide a more versatile system and method for distributing electronic coupons.

29 Claims 2, 24, and 25 each recite a decoder (i.e., the component that extracts coupon data
30 from the horizontal overscan portion of the video signal) integrated into the electronic coupon.

1 Claim 2 specifically recites "wherein the decoder is an integrated part of the electronic coupon, such
2 that the decoder, the display, the at least one control key, the non-volatile memory, and the controller
3 are encompassed in a common housing." Claim 24 specifically recites an electronic coupon
4 comprising a decoder, a display, a memory and a processor. Claim 25 depends from Claim 24.

5 Mankovitz discloses an electronic coupon 10 that couples to an external controller 12 (see
6 FIGURE 1a of Mankovitz), which carries out the decoding function, i.e., the external controller
7 extracts coupon data from the vertical blanking interval of a video signal. The Examiner asserts that
8 because external controller 12 can couple to electronic coupon 10, the electronic coupon comprises
9 the controller, and the controller is encompassed in a common housing. This reasoning is not
10 justified, and the rejection thus appears to be without merit. The prior art clearly teaches that the
11 decoder (i.e., the controller) is a separate component, which is not integral to or part of the electronic
12 coupon. Mankovitz specifically discloses that the electronic coupon includes a display 22, input
13 keys (24, 26, 28, 30, and 62), beeper 44, IR detector 16, connector 20, IR emitter 32, processor 35,
14 clock 42, RAM 36, ROM 46, and driver 40. Controller 12 is clearly described as a separate
15 component, *which is not part of the electronic coupon*. Simply because the electronic coupon
16 described by Mankovitz can couple to the controller to receive data does not make the controller part
17 of the electronic coupon. In an attempt to clarify this distinction, appellant employed the language in
18 the claims on appeal that the elements of the electronic coupon (including the decoder) are
19 encompassed in a common housing. There is simply no reasonable basis for asserting that the
20 housing of Mankovitz's controller is the same as the housing of Mankovitz's electronic coupon.
21 Even when Mankovitz's controller is coupled to Mankovitz's electronic coupon via a hard wire
22 connection, Mankovitz's controller is not enclosed in the same housing as Mankovitz's electronic
23 coupon. Two separate housings, enclosing separate components, are simply not a common housing.
24 The cited art, alone or in combination, therefore does not teach or suggest including a decoder within
25 an electronic coupon, as opposed to implementing the decoder in a separate housing, as a separate
26 device. This distinction is not merely a matter of design, since inclusion of a decoder in the
27 electronic coupon substantially adds to the functionality of the electronic coupon claimed by
appellant, compared to the electronic coupon of Mankovitz.

28 Note that Claims 2, 24, and 25 also recite enabling a user to select at least one coupon
29 category from a menu of coupon categories, and thus these claims also distinguish over the cited art
30 for the reasons discussed above with respect to the rejection of Claims 1, 3-8, 11, 12, 13-23, and 27.

1 Rejection of Claims 9, 10, 26, 29 and 31 under 35 U.S.C. § 103

2 The Examiner has rejected Claims 9, 10, 26, 29 and 31 under 35 U.S.C. § 103(a) as being
3 unpatentable over Williams et al. (U.S. Patent No. 6,075,971) in view of Mankovitz et al. (U.S.
4 Patent No. 5,523,794), and further in view of Small (U.S. Patent No. 5,808,689) and Terrill et al.
5 (U.S. Patent No. 6,052,755). The Examiner indicates that Williams discloses a set up mode, which
6 enables users to complete preference profiles that can be used to filter coupons, and that Mankovitz
7 discloses a portable coupon, including keys, memory, a controller and a display, *and a mode key*.
8 The Examiner appears to conclude that an artisan of ordinary skill would have been led to combine
9 and modify these references to achieve an invention equivalent to appellant's claimed invention in
10 order to provide a more versatile system and method for distributing electronic coupons.

11 Claims 9, 10, 26, 29, and 31 recite an electronic coupon including a single *mode key* that
12 enables a user to select between a storage mode and a redeem mode (or between a set up mode and a
13 storage mode, as recited in Claim 29). Mankovitz discloses an electronic coupon 10 that includes a
14 read key 24 and a save key 28. The Examiner has refused to accept that appellant's single mode key
15 is functionally distinguishable from Mankovitz's read and save keys. Appellant's claims do not
16 recite merely the ability to access a storage mode or a redeem mode (which Mankovitz also does),
17 but instead, recite a specific structure (i.e., a single mode key that implements these functions). In
18 the Advisory Action of March 24, 2004, the Examiner asserts that he takes a broader interpretation
19 of the claimed invention, and thus concludes that a read key and a save key are structurally identical
20 to a single mode key. It is simply illogical to assert that appellant's claimed structure (a single mode
21 key) is structurally and functionally identical to Mankovitz's read and save keys. The Examiner has
22 not cited any art that employs a single mode key in place of a plurality of function-specific keys.
23 The cited art, alone or in combination, does not teach or suggest an electronic coupon that includes a
24 single mode key enabling a user to selectively access a storage mode and a redeem mode.

25 Claims 29 and 31 further recite that the mode key enables the user to access a set up mode, in
26 which the menu of coupon categories is displayed to the user. Mankovitz's electronic coupon does
27 not appear to have a set up mode. Thus, not only is appellant's mode key structurally
28 distinguishable over Mankovitz's multi-key configuration, appellant's mode key performs a
29 distinctly different function that is not taught or suggested by the cited art. While Williams discloses
30 a set up mode, Williams does not teach or suggest the set up mode is accessed by manipulating a
mode key that enables a user to selectively access a set up mode, a storage mode, and a redeem

1 mode. The cited art, alone or in combination, therefore does not teach or suggest an electronic
2 coupon that includes a single mode key enabling a user to selectively access a set up mode, a storage
3 mode, and a redeem mode.

4 Claims 9, 10, 26, 29, and 31 also each recite enabling a user to select at least one coupon
5 category from a menu of coupon categories, and thus, these claims also distinguish over the cited art
6 for the reasons discussed above with respect to the rejection of Claims 1, 3-8, 11, 12, 13-23, and 27.

7 Rejection of Claim 28 under 35 U.S.C. § 103

8 The Examiner has rejected Claim 28 under 35 U.S.C. § 103(a) as being unpatentable over
9 Mankovitz et al. (U.S. Patent No. 5,523,794) in view of Small (U.S. Patent No. 5,808,689). The
10 Examiner indicates that Mankovitz discloses a portable coupon including keys, memory, a controller
11 and a display, *and an integrated decoder*; and that Small discloses encoding and decoding data
12 using the horizontal overscan portion of a video signal. The Examiner appears to conclude that an
13 artisan of ordinary skill would have been led to combine and modify these references to achieve an
14 invention equivalent to appellant's claimed invention in order to provide a more versatile system and
15 method for distributing electronic coupons.

16 Claim 28 recites an electronic coupon that includes a decoder. As discussed above with
17 respect to the rejection of Claims 2, 24, and 25, Mankovitz discloses an electronic coupon 10, and
18 also a separate controller 12 that extracts coupon data from a video signal. The cited art, alone or in
19 combination, does not teach or suggest including a decoder within an electronic coupon, as opposed
20 to implementing the decoder as a separate device.

21 CONCLUSION

22 The art cited by the Examiner in rejecting Claims 1, 3-8, 11, 12, 13-23, and 27 as
23 unpatentable under 35 U.S.C. § 103 does not in combination disclose or suggest the invention
24 defined by these claims. Specifically, the cited art fails to teach steps that are equivalent to
25 displaying a menu of coupon categories during a start up mode, such that only coupons
26 corresponding to the categories thus selected are stored. The coupon filtering method disclosed by
27 Williams is not equivalent to appellant's recited method, because Williams does not teach or suggest
28 the step of displaying a *menu of coupon categories* to a user in a start up mode.

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The art cited by the Examiner in rejecting Claims 2, 24, and 25 as unpatentable under 35 U.S.C. § 103 also does not in combination disclose the invention defined by these claims. Specifically, the cited art fails to teach both equivalent coupon filtering, and an electronic coupon that includes an integral decoder.

The art cited by the Examiner in rejecting Claims 9, 10, 26, 29, and 31 as unpatentable under 35 U.S.C. § 103 does not in combination disclose the invention defined by appellants in these claims. Specifically, the cited art fails to teach or suggest an equivalent to appellant's recited coupon filtering, and fails to teach or suggest a structure equivalent to appellant's recited mode key.

Finally, the art cited by the Examiner in rejecting Claim 28 as unpatentable under 35 U.S.C. § 103 does not in combination disclose the invention defined by this claim. Specifically, the cited art fails to teach an electronic coupon that includes an integral decoder.

Appellant therefore requests that the Board of Patent Appeals and Interferences overrule the Examiner's rejection of the claims.

Respectfully submitted,

Ron Anderson

Ronald M. Anderson
Registration No. 28,829

I hereby certify that this correspondence is being deposited with the U.S. Postal Service in a sealed envelope as first class mail with postage thereon fully prepaid addressed to: Commissioner for Patents, P.O. Box 1450, Alexandria, VA 22313-1450, on June 3, 2004.

Date: June 3, 2004
RMA/MCK:klp

Kathy Davis

APPENDIX

Claims on Appeal:

1. A system for selectively storing and selectively displaying coupons defined by coupon data extracted from a horizontal overscan portion of a video signal, the system comprising:

a decoder configured to receive a video signal during a transmission session and to extract coupon data from the horizontal overscan portion of the video signal producing extracted coupon data, the extracted coupon data defining a plurality of coupons relating to different categories; and

an electronic coupon configured to selectively store and to selectively display coupons defined by the extracted coupon data, the electronic coupon comprising:

a display configured to selectively display coupons defined by the extracted coupon data;

a plurality of control keys configured to selectively respond to actuation by a user;

a non-volatile memory configured to selectively store coupons defined by the extracted coupon data, and

a controller configured to process the extracted coupon data produced by the decoder, the controller being logically coupled to the display, to the plurality of control keys, and to the non-volatile memory, the controller implementing the following functions:

enabling a user to selectively manipulate at least one of the of the plurality of control keys to select a set up mode prior to the transmission session, the controller responding to the selection of the set up mode by causing a menu including a plurality of different coupon categories to be presented to the user on the display;

enabling a user to manipulate at least one of the of the plurality of control keys to select at least one of the different coupon categories displayed in the menu; and

automatically analyzing the extracted coupon data produced by the decoder, such that only coupons defined by the extracted coupon data that correspond to the at least one of the different coupon categories selected by the user in the set up mode are automatically stored in the non-volatile memory, and each coupon defined by the extracted coupon data that does not correspond to the at least one of the different coupon categories selected by the user in the set up mode is automatically discarded.

1 2. The system of Claim 1, wherein the decoder is an integrated part of the electronic
2 coupon, such that the decoder, the display, the at least one control key, the non-volatile memory, and
3 the controller are encompassed in a common housing.

4 3. The system of Claim 1, wherein the electronic coupon further comprises a Liquid
5 Crystal Display (LCD) for displaying a selected coupon.

6 4. The system of Claim 3, wherein the selected coupon is displayed as a Universal
7 Product Code bar code.

8 5. The system of Claim 4, wherein the Universal Product Code can be read by a bar
9 code scanner.

10 6. The system of Claim 1, wherein the transmission session comprises a broadcast of a
11 television program.

12 7. The system of Claim 6, wherein the television program comprises a television
13 commercial.

14 8. The system of Claim 1, wherein the transmission session comprises a play-back of a
15 video taped program.

16 9. The system of Claim 1, wherein at least one of the of the plurality of control keys
17 comprises a mode key, the mode key being operative to select between a storage mode and a redeem
18 mode, such that when in the storage mode, the controller analyzes extracted coupon data and saves
19 coupons corresponding to a selected coupon category, and when in the redeem mode, the controller
20 causes a menu of each coupon stored in the electronic coupon to be presented to the user on the display.

21 10. The system of Claim 9, wherein the mode key is further operative to select the set-up
22 mode.

23 11. The system of Claim 1, wherein the non-volatile memory comprises magnetic media.

24 12. The system of Claim 1, wherein the non-volatile memory comprises an electrical
25 circuit.

26 13. A method for storing coupon data extracted from the horizontal overscan portion of a
27 video signal in an electronic coupon, the method comprising the steps of:

28 providing an electronic coupon configured to selectively store coupons defined by coupon
29 data extracted from the horizontal overscan portion of the video signal during a transmission session,
30 the electronic coupon comprising a controller configured to analyze and manipulate the extracted
 coupon data;

1 before the transmission session, enabling a user to select a set up mode available in the
2 electronic coupon by manipulating a key on the electronic coupon, the controller responding to
3 selection of the set up mode by displaying a menu including a plurality of different coupon
4 categories;

5 enabling the user to select at least one of the different coupon categories;

6 receiving the video signal during a transmission session;

7 extracting coupon data from the horizontal overscan portion of the video signal; and

8 using the controller for automatically performing the steps of:

9 determining a coupon category corresponding to each coupon defined by the
10 extracted coupon data;

11 storing each coupon defined by the extracted coupon data corresponding to a coupon
12 category selected by the user, in the electronic coupon; and

13 discarding each coupon defined by the extracted coupon data that does not correspond
14 to a category selected by the user.

15 14. The method of Claim 13, wherein the transmission session comprises a broadcast of a
16 television program.

17 15. The method of Claim 13, wherein the transmission session comprises a play-back of a
18 video taped program.

19 16. The method of Claim 13, wherein the step of storing each coupon defined by the
20 extracted coupon data corresponding to a coupon category selected by the user comprises the step of
storing the coupon in a non-volatile memory in the electronic coupon.

21 17. The method of Claim 13, further comprising the step of enabling a user to select a
22 redeem mode available on the electronic coupon by manipulating a key on the electronic coupon, the
23 controller responding to selection of the redeem mode by displaying a menu of stored coupons
24 defined by the extracted coupon data corresponding to a coupon category selected by the user.

25 18. The method of Claim 17, further comprising the step of enabling the user to select
26 one of the stored coupons displayed in the menu of stored coupons, the controller responding to
27 selection of one of the stored coupons by displaying the stored coupon.

28 19. The method of Claim 13, further comprising the step of enabling the user to select a
29 storage mode available in the electronic coupon by manipulating a key on the electronic coupon, the
30 controller responding to selection of the storage mode by analyzing the extracted coupon data.

1 20. The method of Claim 18, wherein the coupon displayed comprises a Universal
2 Product Code bar code.

3 21. The method of Claim 20, wherein the coupon displayed can be read by a bar code
4 scanner.

5 22. The method of Claim 16, wherein the non-volatile memory comprises magnetic
6 media.

7 23. The method of Claim 16, wherein the non-volatile memory comprises an electrical
8 circuit.

9 24. An electronic coupon for decoding and selectively storing coupon data that are
10 encoded in a horizontal overscan portion of a video signal, the electronic coupon comprising:

11 a decoder configured to receive the video signal, said decoder processing video signals thus
12 received to decode coupon data that are encoded in the horizontal overscan portion of the video
13 signal, producing decoded coupon data, the decoded coupon data defining at least one coupon;

14 a display configured to selectively display coupons defined by the decoded coupon data;

15 a plurality of control keys configured to be selectively controlled by a user;

16 a memory in which selected coupons defined by the coupon data decoded by the decoder can
be stored; and

17 a processor configured to process the decoded coupon data produced by the decoder, the
18 processor being logically coupled to the display, to the plurality of control keys, and to the memory,
19 the processor implementing the following functions:

20 enabling a user to manipulate at least one of the of the plurality of control keys to
21 select a set up mode prior to a transmission session, the controller responding to the selection of the
22 set up mode by causing a menu including a plurality of different coupon categories to be presented
23 to the user on the display;

24 enabling a user to manipulate at least one of the of the plurality of control keys to
25 select at least one of the different coupon categories displayed in the menu;

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1 automatically analyzing the decoded coupon data produced by the decoder, such that
2 only coupons defined by the decoded coupon data that correspond to a coupon category selected by
3 the user in the set up mode are automatically stored in the memory, and each coupon defined by the
4 decoded coupon data that does not correspond to a coupon category selected by the user in the set up
5 mode is automatically discarded, the decoder, the display, the plurality of control keys, the memory,
6 and the processor being encompassed in a common housing.

7 25. The system of Claim 24, wherein the memory comprises magnetic media.

8 26. A system for decoding and selectively storing coupon data that are encoded in a
9 horizontal overscan portion of a video signal, the system comprising:

10 a decoder configured to receive the video signal, said decoder processing video signals thus
11 received to extract coupon data that are encoded in the horizontal overscan portion of the video
12 signal, producing extracted coupon data, the extracted coupon data defining at least one coupon;

13 an electronic coupon comprising:

14 a receiver adapted to receive the extracted coupon data from said decoder;

15 a memory for use in selectively storing coupons defined by the extracted coupon data;

16 a display enabling a user to selectively view stored coupons defined by the extracted
17 coupon data;

18 a plurality of control keys configured to be selectively controlled by a user, including
19 a mode key that enables a user to toggle between a storage mode, and a redeem mode; and

20 a processor logically coupled to said receiver, to said memory, to said display, and to
21 said plurality of control keys, said processor enabling a user to selectively manipulate the extracted
22 coupon data received from the decoder by the receiver, said processor implementing a plurality of
23 functions, including:

24 enabling a user to manipulate said mode key to select a storage mode,
25 such that only when the storage mode is selected are coupons defined by the extracted coupon data
and received by said receiver stored in said memory; and

26 enabling a user to manipulate said mode key to select a redeem mode,
27 such that when the redeem mode is selected, coupons defined by the extracted coupon data that are
28 stored in said memory are presented to a user on said display as a list that a user can scroll through
29 by manipulating at least one of the plurality of control keys.

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1 27. A system for decoding and selectively storing coupon data that are encoded in a
2 horizontal overscan portion of a video signal, the system comprising:

3 a decoder adapted to receive the video signal, said decoder processing video signals thus
4 received to decode coupon data that are encoded in the horizontal overscan portion of the video
5 signal the decoded coupon data defining at least one coupon;

6 an electronic coupon comprising:

7 a receiver adapted to receive decoded coupon data from said decoder;

8 a memory for use in storing selected coupon data decoded by the decoder;

9 a display enabling a user to view the coupon data decoded by the decoder;

10 a plurality of control keys to selectively control a display of coupon data decoded by
11 the decoder; and

12 a processor logically coupled to said receiver, to said memory, to said display, and to
13 said plurality of control keys, said processor enabling a user to selectively manipulate the decoded
14 coupon data received from the decoder by the receiver, said processor enabling a user to manipulate
15 at least one of said plurality of control keys to select a set-up mode, such that when the set-up mode
16 is selected, a user is presented with a menu comprising a plurality of different categories that a user
17 can select by manipulating at least one of said plurality of control keys, so that said processor
18 automatically evaluates any decoded coupon data received by said receiver, such that decoded
19 coupon data that correspond to a selected category are automatically stored in said memory, and
20 decoded coupon data that do not correspond to a selected category are automatically not stored in
said memory.

21 28. A method for delivering and storing coupon data for an electronic coupon using the
22 horizontal overscan portion of a video signal, the method comprising the steps of:

23 providing an electronic coupon including a decoder configured to extract coupon data from
24 the horizontal overscan portion of the video signal, such that the decoder and other functional
25 components of the electronic coupon are encompassed in a common housing;

26 receiving the video signal at the electronic coupon during a transmission session;

27 extracting coupon data from the horizontal overscan portion of a video signal using the
28 decoder in the electronic coupon; and

29 storing the coupon data extracted by the decoder in the electronic coupon.

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1 29. A method for delivering and selectively storing coupon data using the horizontal
2 overscan portion of a video signal, the method comprising the steps of:

3 providing an electronic coupon comprising a plurality of keys configured to receive input
4 from a user, the plurality of keys including a mode key operative to enable a user to toggle between a
5 start up mode and a storage mode;

6 actuating the mode key to selectively enter the start up mode, such that in response to
7 selection of the start up mode, the electronic coupon automatically displays a menu including a
8 plurality of coupon categories;

9 enabling a user to select at least one coupon category from the menu;

10 actuating the mode key to selectively enter the storage mode, such that in response to
11 selection of the storage mode, the electronic coupon is enabled to automatically evaluate any coupon
12 data extracted from the horizontal overscan portion of a video signal to determine if such coupon
13 data correspond to a coupon category selected in the start up mode;

14 receiving the video signal;

15 extracting coupon data from the horizontal overscan portion of the video signal;

16 automatically evaluating the extracted coupon data with the electronic coupon; and

17 if the extracted coupon data matches a selected coupon category, then automatically storing
18 the extracted coupon data, and otherwise, not storing the extracted coupon data.

19 31. A system for decoding and storing coupon data that are encoded in a horizontal
20 overscan portion of a video signal, the system comprising:

21 a decoder adapted to receive the video signal, the decoder processing video signals thus
22 received to extract coupon data that are encoded in the horizontal overscan portion of the video
23 signal, the extracted coupon data defining a plurality of coupons, at least some of the coupons
24 corresponding to different coupon categories;

25 an electronic coupon comprising:

26 a receiver configured to receive the plurality of coupons extracted by the decoder;

27 a memory configured to selectively store coupons received by the electronic
28 controller;

29 a display enabling a user to selectively view a coupon stored in the memory;

30 ///

1 a plurality of control keys configured to receive an input from a user, including a
2 mode key enabling a user to selectively toggle between a set up mode, a storage mode, and a redeem
3 mode; and

4 a processor logically coupled to the receiver, to the memory, to the display, and to the
5 plurality of control keys, the processor implementing at least the following functions:

6 responding to a user using the mode key to select the set up mode by
7 displaying a menu including a plurality of different coupon categories to the user on the display;

8 enabling a user to manipulate at least one of the plurality of control keys to
9 select at least one of the different coupon categories displayed in the menu in the set up mode;

10 responding to a user using the mode key to select the storage mode by
11 automatically analyzing each coupon defined by coupon data extracted from a video signal by the
12 decoder and received by the electronic coupon, such that only coupons that correspond to a coupon
13 category selected by the user in the set up mode are automatically stored in the memory, and each
14 coupon that does not correspond to a coupon category selected by the user in the set up mode is
15 automatically discarded; and

16 responding to a user manipulating the mode key to select the redeem mode by displaying a menu
17 including each coupon stored in the memory.

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CUSTOMER NUMBER 27792

2 IN THE UNITED STATES PATENT AND TRADEMARK OFFICE
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4 Appellant: Craig Ranta Attorney Docket No: MICR0230
5 Serial No: 09/476,291 Group Art Unit: 2611
6 Filed: December 30, 1999 Examiner: Chung, Jason J.
7 Title: METHOD AND SYSTEM FOR DOWNLOADING, STORING AND
8 DISPLAYING COUPON DATA USING THE HORIZONTAL OVERSCAN
9 PORTION OF A VIDEO SIGNAL

10 APPEAL BRIEF TRANSMITTAL LETTER

11 12 13 14 15 16 17 18 19 20 21 22 23 24 25 26 27 28 29 30 Bellevue, Washington 98004

June 3, 2004

TO THE COMMISSIONER FOR PATENTS:

Enclosed herewith for filing in the above-identified patent application is an Appeal Brief in triplicate. Also enclosed is our check No. 7427 in the amount of \$330. Please charge any additional fees or credit any overpayment to Deposit Account No. 01-1940. A copy of this sheet is enclosed.

Respectfully submitted,

Ronald M. Anderson
Registration No. 28,829

I hereby certify that this correspondence is being deposited with the U.S. Postal Service in a sealed envelope as first class mail with postage thereon fully prepaid addressed to: Commissioner for Patents, P.O. Box 1450, Alexandria, Virginia 22313-1450, on June 3, 2004.

Date: June 3, 2004

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